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As a point of clarification, the requirement for constructive reduction to practice is not based upon the filing of a patent application in the United States, but upon the filing of an application which fulfills 35 U.S.C. §112. MPEP 2138.05. Moreover, constructive reduction to practice results when a foreign application fulfills the requirements of 35 U.S.C. §119 since 35 U.S.C. §119 requires that "[a]n application for patent for an invention filed in this country ... shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed" (emphasis added). As such, the filing of the foreign application is afforded the same statutory presumptions as if the filing was in the United States. Therefore, the filing of the foreign application represents a constructive reduction to practice for the purposes of establishing dates of invention. See, Scott v. Koyama, 61 USPQ2d 1856, 1858 (Fed. Cir. 2002) (Koyama, the senior party, relied on his Japanese filing date of March 13, 1990.... See 35 U.S.C. §119(a) (foreign application 'shall have the same effect as the same application would have if filed in this country on the date' of the foreign filing). Thus a date of constructive reduction to practice for interference purposes may be established by a properly invoked foreign filing date."), In re Mulder and Wulms, 219 USPQ 189 (Fed. Cir. 1983), MPEP 201.13, 201.15, 2138.05.

While the Examiner is correct in that MPEP 715.07(a) cites by way of an example that a constructive reduction to practice would include the filing of a U.S. patent application, MPEP 715.07(a) does not limit the constructive reduction to practice to only the filing of U.S. patent applications. Thus, it is respectfully submitted that the Examiner's reliance and interpretation of MPEP 715.07(a) does not account for the effects of 35 U.S.C. §119 in establishing a constructive reduction to practice based on a foreign filed application.

The Examiner confirms on pages 2-3 of the Office Action that the Declaration under Rule 131 filed September 30, 2003 established a date of conception before the U.S. filing date of

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Cato, and diligence between at least October 8, 1997 and the date of foreign filing. Since the applicants' compliance with 35 U.S.C. §119 further establishes a constructive reduction to practice for the above referenced application of December 13, 1997, it is respectfully submitted that the applicants have established a date of invention sufficient to remove Cato as a reference under 35 U.S.C. §102(e). Therefore, it is respectfully submitted that Cato no longer qualifies as prior art under 35 U.S.C. §102(e) since the invention was not "described in a patent granted on an application for patent by another filed in the United States *before the invention thereof by the applicant for patent.*" MPEP 2136.05, MPEP 715.

REJECTION UNDER 35 U.S.C. §102:

On pages 3-12 of the Office Action, the Examiner rejects claims 16-35 and 37-81 under 35 U.S.C. §102(e) in view of Cato. The rejection is respectfully traversed and reconsideration is requested.

Since Cato is no longer prior art as discussed above, and since the Examiner cites no other prior art as anticipating claims 16-35 and 37-81, it is respectfully submitted that claims 16-35 and 37-81 are deemed patentable.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action at pages 12-14, the Examiner rejects claims 36 and 82-85 under 35 U.S.C. §103 in view of Cato and either the Examiner's taking Official Notice of various elements or Mankovitz (U.S. Patent No. 6,459,719). The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's taking Official Notice of the various elements is proper and Mankovitz discloses the features as described in the Office Action, neither the Examiner's taking Official Notice nor Mankovitz are relied upon as disclosing and do not disclose the features of the recited invention without Cato. Since Cato is not prior art as discussed above, it is respectfully submitted that claims 36 and 82-85 remain patentable over the Examiner's taking Official Notice and/or Mankovitz.

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CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By: James G. McEwen
Registration No. 41,983

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

Date: MARCH 15, 2004CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450
on MARCH 15, 2004

STAAS & HALSEY

By: Date: MARCH 15, 2004